

REMARKS

By this Amendment, Applicants cancel claims 10 and 11, without prejudice or disclaimer of the subject matter thereof, and amend claims 1-3, 6-9, and 12-14 to more appropriately define the present invention. Upon entry of this Amendment, claims 1-9 and 12-16 remain pending and under current examination.

In the Office Action ("OA"), the Examiner rejected claims 1-3 and 6-14 under 35 U.S.C. § 103(a) as unpatentable over Jarett et al., U.S. Patent No. 5,911,120 ("Jarett") in view Bradshaw, Jr., U.S. Patent No. 6,608,820 ("Bradshaw") and rejected claims 4, 5, 15, and 16 under 35 U.S.C. § 103(a) as unpatentable over *Jarett* in view of *Bradshaw* and Grubeck et al., U.S. Patent No. 6,449,484 ("Grubeck").

In response, Applicants respectfully submit that a *prima facie* case of obviousness has not been established by the Examiner.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03, ed. 8, rev. 1 (Feb. 2003) (quoting *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970)). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143 at. 2100-122 to 127.

In both rejections, a *prima facie* case of obviousness has not been established because all three basic criteria have not been established. Applicants will address each rejection separately in further detail below.

I. Rejection of claims 1-3 and 6-14 over Jarett in view of Bradshaw

Claim 1 is directed to a communication terminal comprising a combination of elements including, *inter alia*, “a first radio unit configured to make radio communication with a base station over a first radio channel in accordance with a first radio communication system, the base station via which the communication terminal is connectable with a first communication terminal; a second radio unit configured to make radio communication with a second communication terminal over a second radio channel in accordance with a second radio communication system; and means for connecting the first radio channel and the second radio channel such that a communication channel between the first communication terminal and the second communication terminal can be established.”

In the rejection, the Examiner acknowledged that *Jarett* does not teach means configured to connect the first radio channel to a radio channel such that a communication channel between a first communication channel and a second communication terminal can be established. (OA at 2-3.)

Moreover, *Bradshaw* fails to teach or suggest this claim element. The Examiner alleged that *Bradshaw* discloses connecting a first radio channel to a second communication terminal via a second radio channel, such that a communications channel between a calling party and a second communication terminal can be established via a second radio unit. Applicants respectfully disagree and submit that *Bradshaw* fails to cure the deficiencies of *Jarett*.

Bradshaw is directed to a wireless communication network which allows conference calling. The network comprises several mobile stations 102, 104, 106, and 108. *Bradshaw*, Fig. 1. However, each mobile station only includes a single radio unit. *Bradshaw*, col. 3, ll. 63-68. Each mobile station communicates with other mobile stations through a base station 110.

Bradshaw, col. 3, ll. 63-68. The base station handles all the connections between the mobile

stations. *Bradshaw*, col. 4, ll. 17-36. Thus, the mobile station cannot connect a first and second station over first and second radio channels.

Accordingly, even if *Bradshaw* were properly combinable with *Jarett* (which Applicants do not concede), the combination of *Jarett* and *Bradshaw* would still fail to teach or suggest at least “a first radio unit configured to make radio communication with a base station over a first radio channel in accordance with a first radio communication system, the base station via which the communication terminal is connectable with a first communication terminal; a second radio unit configured to make radio communication with a second communication terminal over a second radio channel in accordance with a second radio communication system; and means for connecting the first radio channel and the second radio channel such that a communication channel between the first communication terminal and the second communication terminal can be established,” as recited in claim 1. Hence, a *prima facie* case of obviousness cannot be established for claim 1 because the cited references fail to teach or suggest all the claim elements. For at least this reason, claim 1 is allowable.

Claims 2 and 3 are allowable at least due to their dependence from allowable claim 1. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” M.P.E.P. § 2143.03 at 2100-126, (citing *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)).

Furthermore, claim 6 is directed to a comprising a combination of elements including, *inter alia*, “making radio communication with a base station over a first radio channel in accordance with a first radio communication system; making radio communication with a second communication terminal over a second radio channel in accordance with a second radio communication system; and establishing a communication channel between the first

communication terminal and the second communication terminal by connecting the first radio channel and the second radio channel.”

As mentioned above, *Jarett* and *Bradshaw*, taken alone or in combination, fail to teach or suggest at least “means for connecting the first radio channel and the second radio channel such that a communication channel between the first communication terminal and the second communication terminal can be established,” as recited in claim 1. Accordingly, *Jarett* and *Bradshaw*, taken alone or in combination, fail to teach or suggest at least “establishing a communication channel between the first communication terminal and the second communication terminal by connecting the first radio channel and the second radio channel,” as recited in claim 6.

Thus, a *prima facie* case of obviousness cannot be established for claim 6 because the references fail to teach or suggest all the claim elements. For at least this reason, claim 6 is allowable.

Claims 7-9 are allowable at least due to their dependence from allowable claim 6.
M.P.E.P. § 2143.03 at 2100-126.

Applicants cancel claims 10 and 11 without prejudice or disclaimer of the subject matter thereof. Accordingly, the rejection of these claims is rendered moot.

Claim 12 is directed to a communication terminal comprising a combination of elements including, *inter alia*, “a first radio unit configured to make radio communication with a base station over a first radio channel in accordance with a first radio communication system, the base station via which the communication terminal is connectable with a first communication terminal; a second radio unit configured to make radio communication with a second communication terminal over a second radio in accordance with a second radio communication

system; means for receiving information of a predetermined type from the base station over the first radio channel; and means for sending the received information to the second communication terminal over the second radio channel.”

As mentioned above, *Jarett* and *Bradshaw*, taken alone or in combination, fail to teach or suggest such an element. *Jarrett* discloses that only one radio unit is used. *Bradshaw* only teaches mobile terminals with a single radio unit. Thus, a *prima facie* case of obviousness cannot be established for claim 12 because the references fail to teach or suggest all the claim elements. For at least this reason, claim 12 is allowable.

Claim 13 and 14 are allowable at least due to their dependence from allowable claim 12.

Moreover, there is no suggestion or motivation to modify *Jarett* and *Bradshaw* to produce Applicants’ claimed invention. Even if the Examiner’s allegations that “[i]t would have been obvious ... [to adapt Jarett] to include a control section,” (OA at p. 2-3) were true (which Applicants dispute), this still does not establish that there would have been the requisite suggestion or motivation to modify *Jarett* to produce Applicants’ claimed invention. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01 at p. 2100-124 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990))

(emphasis in original).

Since *Jarett* and *Bradshaw*, taken alone or in combination, do not teach or suggest all the elements of Applicants’ claimed invention, and there can be no suggestion or motivation in the cited references to modify them, Applicants further submit that the cited references do not suggest the desirability of their modification to produce Applicants’ present invention. Similarly, without any motivation to modify *Jarett* and *Bradshaw*, there can be no reasonable

expectation of success from modifying these references to somehow produce Applicants' present invention.

Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 1-3, 6-9, and 12-14. For at least this reason, claims 1-3 6-9, and 12-14 are allowable.

II. Rejection of claims 4, 5, 15, and 16 over Jarett in view of Bradshaw and Grubeck

Claims 4 and 5 depend from claim 1, and, thus, incorporate the elements of that claim. As mentioned above, *Jarett* and *Bradshaw*, when taken alone or in combination, fail to teach or suggest at least "a first radio unit configured to make radio communication with a base station over a first radio channel in accordance with a first radio communication system, the base station via which the communication terminal is connectable with a first communication terminal; a second radio unit configured to make radio communication with a second communication terminal over a second radio channel in accordance with a second radio communication system; and means for connecting the first radio channel and the second radio channel such that a communication channel between the first communication terminal and the second communication terminal can be established," recited in claim 1 and incorporated in claims 4 and 5. (See current Response, Remarks, Section I.)

Furthermore, *Grubeck* fails to cure the deficiencies of *Jarett* and *Bradshaw*. *Grubeck* teaches a base station that allocates a channel to a group of mobile stations based on their output power demands. *Grubeck*, col. 5, lines 50-60. Mobile stations that have similar output power demands are allocated the same channel. *Grubeck*, col. 5, lines 50-60. However, a base station that allocates the same channel to a group of mobile stations, as taught by *Grubeck*, is not the same as a communication terminal having a control section configured to connect a first radio channel to another communication terminal via a second radio channel, such that a communication channel between the calling party and the another communication terminal can

be established. Therefore, *Grubeck* also fails to teach or suggest at least this element incorporated in claims 4 and 5.

Accordingly, even if *Jarett*, *Bradshaw*, and *Grubeck*, were properly combinable (which Applicants do not concede), the combination would still fail to teach or suggest at least “a control section configured to connect the first radio channel established by the first channel establishing section to the second communication terminal via the second radio channel established by the second channel establishing section, such that a communication channel between the first communication terminal and the second communication terminal can be established via the second radio unit,” as incorporated in claims 4 and 5. Thus, a *prima facie* case of obviousness cannot be established for these claims because the references fail to teach or suggest all the claim elements. For at least this reason, claims 4 and 5 are allowable.

Furthermore claims 15 and 16 depend from claim 12, and, thus, incorporate the elements of that claim. As mentioned above, *Jarett* and *Bradshaw*, when taken alone or in combination, fail to teach or suggest at least “a first radio unit configured to make radio communication with a base station over a first radio channel in accordance with a first radio communication system, the base station via which the communication terminal is connectable with a first communication terminal; a second radio unit configured to make radio communication with a second communication terminal over a second radio in accordance with a second radio communication system; means for receiving information of a predetermined type from the base station over the first radio channel; and means for sending the received information to the second communication terminal over the second radio channel,” recited in claim 12 and incorporated in claims 15 and 16. (See current Response, Remarks, Section II.)

Furthermore, *Grubeck* fails to cure the deficiencies of *Jarett* and *Bradshaw*. *Grubeck* teaches a base station that allocates a channel to a group of mobile stations based on their output power demands. *Grubeck*, col. 5, lines 50-60. Mobile stations that have similar output power demands are allocated the same channel. *Grubeck*, col. 5, lines 50-60. Therefore, *Grubeck* also fails to teach or suggest at least this feature incorporated in claims 15 and 16.

Accordingly, even if *Jarett*, *Bradshaw*, and *Grubeck*, were properly combinable (which Applicants do not concede), the combination would still fail to teach or suggest at least “a receiving section configured to receive information from [a] base station over [a] first radio channel; and a sending section configured to send the received information to the another communication terminal over [a] second radio channel while the receiving section receives the information over the first radio channel,” as incorporated in claims 15 and 16. Thus, a *prima facie* case of obviousness cannot be established for these claims because the references fail to teach or suggest all the claim elements. For at least these reasons, claims 15 and 16 are allowable.

Moreover, there is no suggestion or motivation to modify *Jarett*, *Bradshaw*, and *Grubeck* to produce Applicants’ claimed invention. Even if the Examiner’s allegations that “[i]t would have been obvious ... to make the invention adapt to include a communication terminal with a transmission power of a first radio unit,” (OA at p. 11) were true (which Applicants dispute), this still does not establish that there would have been the requisite suggestion or motivation to modify *Jarett*, *Bradshaw*, and *Grubeck* to produce Applicants’ claimed invention. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P.

§ 2143.01 at p. 2100-124.

Since *Jarett*, *Bradshaw*, and *Grubeck*, taken alone or in combination, do not teach or suggest all the elements of Applicants' claimed invention, and there can be no suggestion or motivation in the cited references to modify them, Applicants submit that the cited references do not suggest the desirability of their modification to produce Applicants' present invention. Similarly, without any motivation to modify *Jarett*, *Bradshaw*, and *Grubeck*, there can be no reasonable expectation of success from modifying these references to somehow produce Applicants' present invention.

Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 4 and 5. For at least this reason, claims 4 and 5 are allowable.

III. Conclusion

In view of the foregoing, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 11, 2004

By: Richard V. Burgujian Reg. No. 31,744
for Richard V. Burgujian
Reg. No. 31,744